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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,107	12/13/2000	Kenji Fujioka	F-6779	3664

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Jordan and Hamburg  
122 East 42nd Street  
New York, NY 10168

EXAMINER

ENATSKY, AARON L

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 06/17/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/736,107

Applicant(s)

FUJIOKA ET AL.

Examiner

Aaron L Enatsky

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-12 and 14-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-12 and 14-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>3/9/04</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

Art Unit: 3713

## **DETAILED ACTION**

### ***Response to Amendment***

Examiner acknowledges receipt of a RCE and a notice of appeal on 2/17/04. In an interview conducted with Applicant's representative, Examiner clarified that Applicant intended the RCE to supercede the notice of appeal. Examiner's response to the RCE is found below.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-4, 6-12, 14-34 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The last paragraph of claims 1, 4, and 7 require that character data is initial values and a given item. However, dependent claims discuss character data as newly trained values. This discrepancy does not clearly indicate what data is transferred from the device. Applicant needs to clarify the exact composition of the transferred data.

The last paragraph of claims 1, 4, and 7 states, "transferring character data of the character *when* judged by the judger as having been successfully trained to an external side *when* a transfer mode is instructed, ". It is unclear to the Examiner whether Applicant has placed two conditional statements regarding when data can be transferred, whether the language indicates incremental steps in a method, or transferring character data is only dependent on a single condition. The points of contention are the italicized *when*, which appear to be conditional statements.

Art Unit: 3713

Claims 14-19 are dependent on claim 13, which has been cancelled by Applicant's amendment. Applicant needs to fix dependency or rewrite claims in an independent form.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-4, 6-12, 14-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,971,855 to Ng in view of Pokemon in view of US Patent No. 6,009,458 to Hawkins et al. (Hawkins).

Ng teaches a monitor for displaying game images (Fig. 3A), a plurality of operable members (Fig. 3A-3 C), a data transmitter for transmitting data to an external device (Fig 1B), a mode for training a character (6:34), a mode for transmitting data (Fig. 1B), buttons to train a character (6:15-24), a microprocessor controller which drives the game device (5:1-16), obtaining training values which add or subtract from an initial training value (5:51-65), item giving device for giving items to a character which affect training score/state (6:34-47), a training judge for determining a successful endeavor (6:45-47), data of a trained fighter is transmitted to an external device for participating in a game (7:42-8:44). Ng does not disclose transmitting initial training values and items to an external side along with data of a successfully

Art Unit: 3713

trained character. Pokemon teaches a game where users build, train, and trade game characters to participate in battle games (Pg. 1-9). Pokemon allows a user to view the data of any character you have seen or captured (Pg. 10, POKEDEX). The data are statistics including initial and current training values of game characters (Pg. 11, STATS), i.e. ATTACK (current training value) and OT (an initial training value). Pokemon also allows a user to collect items that can be viewed when requested (Pg. 12, ITEM). Some of the items affect the training values of the characters (Pg. 41-42). An impetus behind Pokemon's battle game is to collect different characters to help win the game, wherein one of the major ways to collect different characters is to trade with other people and to grow characters faster (Pg. 23, 30, and 35). During a trade, a character and all of its STATS values will be transmitted to the external link (Pg. 36-38). Thus, one would be motivated to modify Ng to use character trading to add greater depth in the character training/battle game by adding additional characters with which to complete the game and trading characters also provides another method with which to obtain faster character growth (Pg. 35). Such trading insures that a game's dynamic is not limited to a predefined program increasing entertainment value. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ng to use the trading features taught by Pokemon to increase the game's dynamic and entertainment value. Ng in view of Pokemon does not however, teach trading items given to a player. Hawkins teaches a character training game that allows a user to build characters and items to apply in different games, as well as for trade (2:65-3:52). Hawkins is yet another established character building game that also provides for network and system independent game play (5:40-6:11). In this system Hawkins allows users to trade or sell playing objects between users or a central facility (16:1-17:20). The distinct

Art Unit: 3713

advantage of Hawkins's character building game is that playing objects would not be limited to a particular game, nor games in general (21:35-22:30), thus creating a larger base of potential user. A larger user base would make the game more marketable, making it obvious to one of ordinary skill in the art at the time the invention was made to modify Ng in view of Pokemon to use the trading features of Hawkins to increase the marketability of the game.

Ng discloses various commands related to transmitting and receiving data to and from an external device (8:50-11:10). Furthermore, claims of such, directed to communication between devices are standard and well known in computer communication. Applicant does not set forth any novel communication techniques that would further distinguish the invention from previous communication protocols that one of ordinary skill in the art would readily recognize to implement for this application.

Ng discloses using a cable for data communication (2:65-67).

Ng teaches the claimed limitations as discussed above, but does not specifically disclose transmitting items given to a character to an external device. However, Ng teaches bi-directional communication between a first device and a variety of other devices, such as another game apparatus or a PC. Ng also teaches of a first device receiving feature upgrades and restoring aspects of training scores, which would be receiving items from a remote device to affect training scores as paralleled above in providing items per-programmed into the device (2:33-60). Ng also provides for a competition game of combat over the Internet between two remote game devices. It is considered well within one of ordinary skill in the art to provide combat characters with weapons for battling other character. As such, an item could be received for training a fighter for later combat games, therefore when playing a combat game between two remote

Art Unit: 3713

fighters, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ng to provide for sending an item used for training with the fighter data, so that during the combat game a fighter could use that sent item during combat.

Ng teaches receiving from an external source items and other character modifications. Ng also teaches having the ability to train more than one character (5:47-50). While not disclosing where the other characters are produced in the game, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have received the extra characters from the computer or the Internet to provide a new sales distribution channel for the game manufacturer or provide a game player with character variety to keep the combat game more interesting.

Ng teaches having a user post game scores to a website (2:47-49) and transmitting various statistics of a user's virtual character (9:1-10:67) as discussed above. Ng does not disclose displaying how many times a character has been transmitted to an external device nor displaying the information on the monitor, however as taught by Ng, one could readily access how many time transfers have occurred through a player's combat history with other players seen on the score posting on the Internet. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the scores posted to monitor of the game device so that statistics of the game history would be portable with the device and viewable while not connected to the network.

Ng teaches of a first game of training and developing a character, and another video game program where characters participate in a combat game (Abstract). Ng teaches receiving new characters and new character enhancements as discussed above where the character

Art Unit: 3713

enhancements are received from an external device (2:47-60). Items different than those already received by a character would be the new enhancements that are available on an external device through the web.

Ng teaches setting probability for a plurality of experience points through teaching randomly assigned point values (7:41-8:21).

Ng teaches that known prior art hand-held game apparatuses used wireless connections as well as the above described cable connection. Although Ng does not teach an embodiment using a wireless connection, replacing a cable communication mechanism has well known art-accepted advantages over a tethered connection. One distinct advantage of using a wireless connection is long-range portability from a communication point and the elimination of wire clutter. Therefore, one would be motivated to modify Ng to use wireless interconnection methods to allow for remote, longer distance communication and the elimination of wires. Infrared signals for wireless communication are considered analogous and art accepted equivalents to wireless radio communication methods.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-4, 6-12, 14-34 have been considered but are not considered persuasive in view of the new rejection. Additionally, Applicant provides arguments concerning a second game player receiving and training a character. Examiner believes that these arguments are not coterminous with current claims. Applicant's current claims only require that character data is transmitted to an external link.



Art Unit: 3713

*Citation of Pertinent Prior Art*

US Patent No. 4,858,930 to Sato teaches a character training game that is played on a first game and character data is transferred to an external link to be played on a second game machine.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8-6 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALE



MICHAEL O'NEILL  
PRIMARY EXAMINER